

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
September 6, 2005  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Beneficial Franchise Company, Inc.

v.

Ladenburg Thalmann & Co. Inc.

Cancellation No. 92032506  
against Registration No. 2043314

David A. Einhorn, Kanishka Agarwala and James M. Andriola of  
Anderson Kill & Olick, P.C. for Beneficial Franchise  
Company, Inc.

Michael Chiappetta of Fross Zelnick Lehrman & Zissu, P.C.  
for Ladenburg Thalmann & Co. Inc.

Before Quinn, Bucher and Kuhlke, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On November 21, 2001, Beneficial Franchise Company,  
Inc. (petitioner) filed a petition to cancel Registration  
No. 2043314 owned by Ladenburg Thalmann & Co. Inc.

(respondent). This registration is for the mark **SERVING THE  
SMART MONEY SINCE 1876** (standard character drawing). The  
involved registration issued on March 11, 1997, as a result  
of an application filed on February 22, 1996. The services

in the registration are recited as "stock brokerage, security brokerage, investment banking, investment brokerage, investment consultation, financial planning, financial research, financial management, [and] investment management" in International Class 36. The registration alleges a date of first use and a date of first use in commerce of at least as early as December 12, 1995.<sup>1</sup>

Petitioner seeks to cancel respondent's registration on the ground that there is a likelihood of confusion with its **SMART MONEY** mark. Petitioner claims this mark has acquired distinctiveness as a result of continuous and exclusive use in connection with interactive software, and related financial services, from September 1991 until the present. Petition to cancel, ¶¶ 1 - 14. Petitioner also claims ownership of Reg. No. 2095401 for the mark **SMART MONEY** (standard character drawing) registered in connection with "interactive computer programs for educational use, and instructional manuals sold as a unit therewith."<sup>2</sup> Additionally, petitioner alleges that respondent's mark is deceptive under Section 2(a) of the Act and/or deceptively

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<sup>1</sup> Reg. No. 2043314, Section 8 affidavit accepted.

<sup>2</sup> Reg. No. 2095401 issued on September 9, 1997, alleging a date of first use and a date of first use in commerce at least as early as September 1991; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

misdescriptive under Section 2(e)(1) of the Act. Petition to cancel, ¶¶ 15 - 18.

Respondent denies all of the salient allegations of petitioner, and asserts the following affirmative defenses: petitioner's abandonment of the mark, that petitioner's mark is merely descriptive under Section 2(e)(1) of the Act, and that petitioner's claims are barred by laches, acquiescence, estoppel and waiver.

Moreover, respondent counterclaimed to cancel Reg. No. 2095401, the registration referred to above. As grounds for cancellation, respondent asserts that the mark **SMART MONEY** is merely descriptive and has not acquired distinctiveness as a source indicator, that petitioner has abandoned any rights it may have had in this mark, and that the term as used by petitioner does not function as a trademark.<sup>3</sup>

Petitioner answered the counterclaim by denying that the mark is merely descriptive for the goods specified in the registration, by denying respondent's other salient allegations, and by asserting the following affirmative defenses: that respondent's counterclaim based on abandonment fails to state a claim upon which relief can be

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<sup>3</sup> Respondent has failed to explain, prove or brief the particulars of why this term does not function as a mark, so we assume this claim was dropped from this litigation long prior to briefing for final decision.

granted, and that respondent's counterclaim is barred by the doctrine of unclean hands.<sup>4</sup>

### ***The Record***

A trial was conducted in accordance with the Trademark Rules of Practice. Testimony and evidence were introduced by both parties. Pursuant to a stipulation of the parties, testimony in this case was offered by petitioner and by respondent in the form of affidavits/declarations. 37 CFR §2.123(b); TBMP §713.02 (2d ed. rev. 2004). The parties have also stipulated to the authenticity of documents that were filed during their respective testimony periods as well as of two of petitioner's licensing agreements submitted during a brief reopened testimony period. The record before us in this proceeding also includes the declarations of Christine M. Lloyd,<sup>5</sup> of Allison Strickland,<sup>6</sup> and of Emily Dowdall,<sup>7</sup> all with their respective exhibits. Both parties have also stipulated to the submission of responses to

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<sup>4</sup> Inasmuch as these issues were not briefed by petitioner, we assume they were dropped at some juncture prior to briefing for final decision.

<sup>5</sup> Ms. Lloyd is the Regulatory Compliance Auditor and Community Reinvestment Officer and Manager of Beneficial National Bank, U.S.A., a sister corporation of petitioner.

<sup>6</sup> Ms. Strickland is a member of the law firm of Fross Zelnick Lehrman & Zissu, P.C.

<sup>7</sup> Ms. Dowdall is a legal assistant in the law firm of Fross Zelnick Lehrman & Zissu, P.C.

discovery requests and other documents produced during discovery. Respondent submitted, *inter alia*, dictionary entries and magazine publications by way of its Notice of Reliance of October 6, 2003.

Both parties have fully briefed the significant issues remaining in these proceedings, but neither party requested an oral hearing.

Based upon careful consideration of this record, the arguments presented in the briefs and the relevant legal precedents, we hold that the petition for cancellation of Reg. No. 2043314 must be denied, and that the counterclaim for cancellation of Reg. No. 2095401 must also be denied.

### ***Preliminary matters***

Petitioner objects to respondent's introduction of copies of Trademark Trial and Appeal Board files of three proceedings brought by petitioner against a third party (Opposition Nos. 91099181, 91099257 and 91099641) "because respondent has neither averred nor adduced certification that the annexed documents constitute the entire record of those proceedings."

Respondent counters that all the relevant information is contained in the Notice of Opposition, Amendment and Withdrawal of Opposition. Furthermore, respondent argues

that these are "official records" admissible by notice of reliance under Trademark Rule 2.122(e).

According to the language of the rule, an official record of the United States Patent and Trademark Office (USPTO) need not be certified in order to be offered into evidence. The portions of earlier proceeding files respondent has noticed are self-authenticating, official records of the USPTO. The copies are not reproduced from respondent's private files, but are clearly copies of pleadings, amendments and withdrawals of Opposition marked-up by USPTO employees and taken from USPTO application/registration files. Osage Oil & Transportation, Inc. v. The Standard Oil Company, 226 USPQ 905, 906 n.5 (TTAB 1985); and Harzfeld's, Incorporated v. Joseph M. Feldman, Inc., 184 USPQ 692, 693 n.4 (TTAB 1974). In view thereof, petitioner's objection to this evidence is overruled.

Petitioner also objects on grounds of relevancy to respondent's introduction into evidence of third-party registrations inasmuch as respondent has not introduced evidence that these marks are in use. These registrations fall into two categories: trademarks including the term "smart money," as well as registrations showing patterns on the register where other allegedly weak words or terms are incorporated into the longer slogans of competitors.

We overrule petitioner's objections regarding third-party registrations of these several types of marks. We have considered this evidence for whatever probative value it may have, but do not find it appropriate to exclude this type of evidence, which is routinely offered in Board proceedings. See The Sports Authority Michigan, Inc. v. The PC Authority, Inc., 63 USPQ2d 1782 (TTAB 2002); TBMP §704.07 n.180 (2d ed. rev. 2004).

The parties stipulated to the authenticity of two license agreements, one between petitioner and Household International, Inc., and a second between petitioner and HSBC Bank USA. However, respondent expressly reserved the right to object to this evidence on the grounds of relevancy, and has done so. While we find this evidence to be relevant and have considered it, for all the reasons given by respondent, we agree that this evidence has very little probative value.

### ***Facts***

Petitioner is a financial services company with a focus on providing credit, personal loans and loan insurance to individual consumers. As part of its commitment to responsible money management, it has supported credit education programs, including a software package it

developed in 1991 that was to be installed free of charge in kiosks in high schools for use in economics and life skills courses. Petitioner's materials stated that "[w]ith the exception of the opening screen showing Beneficial's sponsorship of *Smart Money*, the game is free of any corporate advertising and any attempt to sell Beneficial products or services." (Bates No. BFC0059) Although petitioner spent more than \$500,000 on the initial development costs of this interactive video game (1989 to 1991) (Bates No. BFC0059), and up to a combined total of a million dollars for additional equipment and promotional expenses by 1995 (Bates No. BFC0466), it seems that from 1995 to 2000, petitioner had only a single copy of the program on one twelve-inch laser disc, was faced with issues over compensation for the actors if it were changed into a different format, and experienced a persistent inability to get it reformatted for use on CD-ROMs or available over the Internet (Bates No. BFC0467-475).

Respondent has been in the investment banking business since 1876. Respondent provides a wide variety of investment banking services, targeting primarily high net worth individuals and large institutions. According to respondent, in December 1995, when it adopted the slogan SERVING THE SMART MONEY SINCE 1876, the term "smart money"



was intended to allude to the intelligence of respondent's knowledgeable investors. Respondent presents its slogan on its website, in promotional materials and on company letterhead - all of which prominently display respondent's LADENBURG THALMANN house mark.

## ***Analysis***

### ***Standing***

It is clear that the petition to cancel adequately sets forth petitioner's standing in view of its ownership and rights in the term SMART MONEY, combined with a non-frivolous allegation of confusing similarity. The counterclaimant's standing is inherent in its position as respondent. See Ohio State University v. Ohio University, 51 USPQ2d 1289, 1293 (TTAB 1999); and TBMP §319.03 (2d ed. rev. 2004).

### ***Is Petitioner's SMART MONEY mark merely descriptive?***

Before considering petitioner's petition based on likelihood of confusion, we turn to respondent's counterclaims against petitioner's pleaded registration.

Petitioner is using the term SMART MONEY in connection with "interactive computer programs for educational use ... ." While the record shows that the purpose of this game is to

teach high school students responsible budgeting, money management and how to use credit responsibly, this subject is not specified in the identification of goods.

More importantly, while the term "smart money" is a common expression connoting "investments made by people experienced and well informed in matters of finance,"<sup>8</sup> and this term has been used as part of other trademarks and/or slogans for finance-related goods and services, we find that the term does not convey information about petitioner's game with the requisite degree of specificity to find that it is merely descriptive. Accordingly, while this may be highly suggestive of such goods, respondent has failed to demonstrate that it is merely descriptive under any test for mere descriptiveness used by various circuit courts.<sup>9</sup>

### ***Has Petitioner abandoned its SMART MONEY mark?***

While respondent's counterclaim alleges that petitioner has abandoned its SMART MONEY mark, this allegation merited very little attention on the part of either party by the time of final briefing.

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<sup>8</sup> Respondent's notice of reliance, Exhibit A, and Dowdall declaration, Exhibit B.

<sup>9</sup> Inasmuch as respondent has failed to show this matter to be merely descriptive, we need not consider the question of whether petitioner has supplied sufficient evidence of record to establish acquired distinctiveness.

We note that in discussing why there have been few opportunities for actual confusion between these marks, petitioner admits that its use of SMART MONEY prior to April 1, 2004 was extremely limited. We have made reference above to a period of years during which time petitioner supported a minimal deployment of the involved software. Nonetheless, during this period, it appears as if petitioner made continuing attempts to get the software changed into a CD-ROM format or one that could be downloaded over the Internet. Furthermore, while its recent license agreements may well be, as respondent claims, little more than petitioner's attempts to extend its mark in the midst of this litigation, it is consistent with an ongoing intention to continue making use of this mark in connection with interactive video games, if not seeking a wider range of goods and services in connection with which petitioner intended to extend the use of this mark.

Section 45 of the Trademark Act provides, in pertinent part, that a mark is abandoned when the following occurs:

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be *prima facie* evidence of abandonment. "Use" of a mark means the *bona fide* use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

A party claiming abandonment has the burden of establishing the case by a preponderance of the evidence. On-line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). The circumstances of this case clearly do not support an inference, as alleged by respondent, that petitioner ever really discontinued use of the mark with the intention not to resume such use. Accordingly, we deny respondent's counterclaim to cancel petitioner's registration on the basis of abandonment by petitioner of this mark for use in connection with interactive video games.

Hence, respondent's counterclaim for cancellation of Reg. No. 2095401, based upon mere descriptiveness and abandonment, is hereby denied.

### ***Priority***

We turn then to the issue of priority of use by noting that "a presumption of validity attaches to a service mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence." West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ 1660, 1662 (Fed. Cir. 1994). See also Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); and Martahus v.

Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).

The application that matured into respondent's registration was filed on February 22, 1996. That date is significant because respondent can rely on this date for its priority, and in order to prevail on priority, petitioner would have to establish an earlier date. 15 U.S.C.

§ 1057(c). See Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n.5 (TTAB 1985) ["The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application"].<sup>10</sup>

Regarding petitioner's use of the mark, SMART MONEY, the evidence of record establishes that petitioner has used this mark on promotional pamphlets as well as software packages (software, workbooks, teacher's guides, etc.) since 1991.<sup>11</sup> Moreover, the March 14, 1991 filing date of

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<sup>10</sup> Respondent's application asserts a date of first use and first use in commerce of December 12, 1995. In this proceeding, respondent does not attempt to establish a date of first use that is significantly earlier than its filing date. For example, there is evidence in this record that respondent began in December 1995 introducing to its clients its new slogan, "Serving the smart money since 1876." (Bates No. LBU0688).

<sup>11</sup> Lloyd declaration at ¶¶4 and 7, and documents attached thereto.

petitioner's pleaded registration precedes the filing date of respondent's registration.<sup>12</sup>

Inasmuch as both the filing of petitioner's application and its date of first use in commerce took place four to five years prior to respondent's dates of first use, priority clearly lies with petitioner.

### ***Likelihood of Confusion***

Having determined that petitioner has priority, we turn to the question of whether contemporaneous use of the parties' marks is likely to cause confusion. Our determination under Section 2(d) of the Act is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties

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<sup>12</sup> This registration is still valid and may be relied upon inasmuch as we have denied respondent's counterclaim, *supra*.

as to appearance, sound, connotation and commercial impression.

As to aural differences, three syllables comprise the term SMART MONEY while SERVING THE SMART MONEY SINCE 1876, when spoken, is more than a dozen syllables. As to appearance, one is a short, two-word term while the other is a longer phrase in the nature of a slogan. Thus, these two marks are very different as to sound and appearance.

As to connotation and commercial impression, it is true that respondent has incorporated petitioner's entire mark into its slogan. However, this record also shows that the term "smart money" is used fairly pervasively in the finance industry. Accordingly, we agree with respondent's conclusion that customers in the financial industry have become conditioned to distinguishing between marks containing the term "smart money" on the basis of minor distinctions. Here, these marks differ substantially in connotation and commercial impression. Clearly, within the context of respondent's slogan, the term "smart money" is a reference to respondent's customers. This longer phrase also conveys a very specific piece of information about the longevity of respondent as a provider of financial services. By contrast, petitioner's "smart money" mark is a much more

amorphous use of a common term used in the finance industry and in educational programs on personal finances.

Accordingly, we agree with respondent that the dissimilarity of the marks in their entireties makes it unlikely that confusion would result from the contemporaneous use of these marks by different parties. Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

We turn next to the du Pont factor focusing on the relationship of the services as recited in respondent's registration to the goods identified in petitioner's registration and in connection with which petitioner's prior mark is in use.

We agree with respondent that petitioner's interactive, educational games for high schoolers are unrelated to respondent's investment banking services. We do not find compelling petitioner's argument that this learning tool will create significant goodwill that carries over to its core business. Moreover, even if this were true, the record shows that petitioner's services are primarily consumer loans, and that its services do not include investment banking as recited in respondent's registration.

In support of its position, petitioner cites to The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d



1715 (TTAB 1991). However, in that case, plaintiff's wide range of investment, financial and securities services included *educational seminars for securities professionals*, while defendant's *educational* services were explicitly recited as providing *seminars* to train individuals to become licensed *securities representatives*. Thus, while Chicago Corp. involved closely-related services, that is clearly not the case herein.

Moreover, petitioner claims that "companies related to Petitioner, to which Petitioner has licensed its SMART MONEY mark are in the business of providing banking and financial services and are well-known for the same." However, we agree with respondent that petitioner has failed to demonstrate any use of the mark SMART MONEY by any of these companies. While petitioner did execute several license agreements with its own family of corporate affiliates on the eve of final briefing in this case, there is no evidence that such use has ever been made. As a result, this key factor also favors respondent.

As to two related du Pont factors focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made, we find that the parties' goods and services are offered to completely different

consumers through different channels of trade and under vastly different conditions. Petitioner's interactive software is only available in high schools, while respondent's services are targeted to high net worth individuals and large institutions. Under the circumstances of this case, we are not persuaded by petitioner's rather tenuous argument that today's student sitting through a high school, life skills course becomes tomorrow's investor. Accordingly, these factors too favor respondent.

As to the du Pont factor focusing on the fame of petitioner's prior mark, we have seen that for much of the first decade after it was developed, petitioner's interactive software enjoyed extremely limited distribution, even among participating high schools. In the less-distant past, even if we were to find some probative value in its recently-executed license agreements involving the mark SMART MONEY, we agree with respondent's conclusions that "the alleged notoriety of companies related to petitioner [Household International, Inc. or HSBC Bank USA] has absolutely no bearing on the strength of the SMART MONEY mark." Hence, this is a neutral factor.

As to the du Pont factor focusing on the number and nature of similar marks in use on similar goods and/or services, we find that proven usage by third parties of

identical marks on similar goods and services demonstrates that the mark is relatively weak and entitled to a narrow scope of protection. Additionally, petitioner's own willingness, as a plaintiff in multiple oppositions, to terminate these proceedings with third parties who are claiming rights to substantially-identical marks on closely-related goods (e.g., by those defendants/applicants amending their identifications of goods, for example, by excluding educational software directed to students) undermines petitioner's arguments as to the strength of its SMART MONEY mark as applied to this educational software.

We turn next to the du Pont factors focusing on the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. We recognize that evidence of actual confusion is notoriously difficult to obtain. However, the absence of any actual confusion over nine years of co-existence may also reflect the fact that the parties' goods and services are offered to completely different consumers through different channels of trade and under vastly different conditions, and that petitioner's usage of its mark has been

quite limited.<sup>13</sup> This factor is neutral or slightly in favor of respondent.

Turning next to the du Pont factor focusing on the variety of goods on which a mark is or is not used, we have seen that this record demonstrates that petitioner has used the name SMART MONEY in a most limited manner, and only in connection with a single product. Hence, the scope of its rights is extremely narrow at best, and this is a neutral factor, or slightly in favor of the position taken by respondent that there is no likelihood of confusion herein.

As to the du Pont factor focusing on the extent to which petitioner has a right to exclude others from use of its mark on its goods, respondent argues as follows:

Undermining Petitioner's position in this proceeding, Petitioner has specifically consented to third party registration of the SMART MONEY mark for goods far more alike Petitioner's goods than Respondent's services. By way of example, Petitioner filed Opposition Nos. 99,181, 99,257 and 99,641 against applications to register the mark SMART MONEY for computer game discs and software and other finance-related computer programs. To settle these opposition proceedings, Petitioner withdrew the

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<sup>13</sup> We should note that we find unconvincing petitioner's claims that respondent only began extensively to advertise its mark in 2001. The record shows that in the period between 1997 and 2001, the promotion and advertising expenditures of respondent's firm aggregated one million dollars. This would suggest that if a substantial number of the members of the relevant population knew of petitioner's goods, there was indeed a chance for actual confusion to have occurred.

oppositions with prejudice "in light of the amendments to the identified goods filed by Applicant in the applications at issue." (RNR, ¶ 4, Ex. F.) Although the marks were identical and the goods were so incredibly similar to Petitioner's services, Petitioner was satisfied with simple amendments of the applications to clarify that the applicant's goods and services did not target children. Specifically, the amendments for educational software added language such as "excluding programs designed for academic use for students," "for the adult investor," etc.

We agree with respondent that petitioner's own actions support the conclusion that it has chosen to exercise a very narrow zone of exclusion when dealing with the use by third parties of substantially identical marks on closely-related goods, and hence, this factor favors respondent.

In conclusion, upon weighing all the relevant du Pont factors in this case, and giving each its appropriate weight, we do not find a likelihood of confusion herein. We find that respondent is favored on two key considerations, i.e., that the parties' marks are quite dissimilar in appearance, sound, connotation and commercial impression, and the parties' respective goods and services are not related. Moreover, on this record, we have found that

petitioner's prior mark is weak and commands only a narrow scope of protection.<sup>14</sup>

***Respondent's slogan mark: deceptive and/or deceptively misdescriptive?***

Petitioner argues that respondent's use of its slogan falsely implies that the services offered by respondent under its mark " ... have been approved, endorsed, sponsored, affiliated with or otherwise associated with the term 'Smart Money' since 1876." (Petitioner's brief, p. 8) According to petitioner, "[t]his false implication is further buttressed by the mark's statement that Respondent has been 'serving' the 'smart money,' i.e., providing services under that mark, during that time." Id. As a result, petitioner argues that respondent's slogan is deceptive and/or deceptively misdescriptive.

In turn, respondent argues that " ... Petitioner makes the *bizarre argument* that Respondent's slogan is deceptively misdescriptive ... " (*emphasis supplied*). While both strongly-stated positions on this issue appear to reflect the work of dedicated advocates, we find little support for petitioner's arguments related to the misleading nature of

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<sup>14</sup> Because we find no likelihood of confusion, respondent's affirmative defenses of laches, acquiescence, estoppel and/or waiver need not be considered.

respondent's registered slogan. While respondent has been using this particular expression only since 1995, the unrefuted evidence of record shows that respondent has been in business since 1876. At worst, respondent's slogan is mere puffery that can hardly be proven to be inaccurate. Thus, this phrase cannot be deemed to be misleading or deceptive. Rather, as respondent contends, the "smart money" portion of its mark simply suggests that respondent's investors are intelligent and knowledgeable.

To find that a mark is deceptively misdescriptive within the meaning of Section 2(e)(1) of the Trademark Act, the mark must misdescribe the goods in such a manner that consumers would be likely to believe the misrepresentation. In re Quady Winery, Inc., 221 USPQ 1213, 1214 (TTAB 1984). After carefully considering the record and the parties' arguments, we find that petitioner has not established that SERVING THE SMART MONEY SINCE 1876 either misdescribes or misrepresents respondent's financial services. Rather, it appears to be a phrase that vaguely suggests, as in advertising puffery, longevity in offering financial services to knowledgeable investors. Most significantly, we find it is not credible that respondent's use of this slogan could possibly conjure up petitioner's interactive video game in the minds of those seeing it. That is, petitioner

has failed to establish that the words "smart money" in the middle of respondent's slogan would be perceived by relevant consumers as connoting petitioner's goods. Thus, we find that respondent's mark is not deceptively misdescriptive.

We also find that applicant's mark is not deceptive. The test for determining whether a mark is deceptive under Section 2(a) is stated by the Court of Appeals for the Federal Circuit:

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?

In re Budge Manufacturing Co., Inc., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). See also, In re Woolrich Woolen Mills, Inc., 13 USPQ2d 1235 (TTAB 1989). Because, as discussed above in the context of misdescriptiveness, respondent's mark satisfies none of the above requirements of the test for deceptiveness, we conclude that respondent's mark is not deceptive.

*Decision:* The petition for cancellation of Reg. No. 2043314 is hereby denied, and the counterclaim for cancellation of Reg. No. 2095401 is also hereby denied.